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APPEAL BRIEF

Atty. Docket No. 30841-703.201

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application	)	
	)	Confirmation No.: 3033
Inventors: Katharine Russell, et al.	)	
	)	Art Unit: 3627
Application No.: 10/001,420	)	
	)	Examiner: Andrew J. Rudy
Filed: November 1, 2001	)	
	)	Customer No. 021971
Title: System and Method for Conducting Pet	)	
Death, DNA and Other Pet Related	)	
Transactions Over a Computer Networks	)	

**APPELLANTS' BRIEF PURSUANT TO 37 C.F.R. § 41.37**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir/Madame:

Appellants submit this corrected brief in accordance with the provisions of 37 C.F.R. § 41.37 in response to a Notification of Non-Compliant Appeal Brief (Notification) mailed July 27, 2006, and requiring correction by August 27, 2006. This corrected brief is being timely filed within the one month or thirty days from the mailing date of the Notification. Please charge the fee required under 37 C.F.R. 41.20(b)(2) deposit account No. 23-2415.

Furthermore, it is much appreciated that on August 9, 2006, in a telephonic conference, Supervisory Patent Examiner Alexander Kalinowski expressed to Applicants' representative Ray Akhavan that the Notification was entirely based on the improper citations to the specification in the appeal brief. In particular, Mr. Kalinowski indicated the Notification requires citations to the actual filed specification and not the published version of the specification. Accordingly, the citations in the corrected brief below have been modified to reference the specification as filed and not the published version of the application. Therefore, it is respectfully submitted that the corrected brief is compliant with all requirements under 37 C.F.R. § 41.37.

**I. REAL PARTY IN INTEREST (37 C.F.R. §41.37 (c)(1)(ii))**

The real party in interest is the assignee MyEtribute, Inc. by virtue of an assignment executed by the inventors. The assignment was recorded in the U.S. Patent and Trademark Office on May 7, 2002 at Reel/Frame 012880/0753.

**II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. §41.37 (c)(1)(ii))**

There are no related appeals or interferences.

**III. STATUS OF CLAIMS (37 C.F.R. §41.37 (c)(1)(iii))**

Claims 1, 4, 6-11 and 19-24 are pending. Claims 2, 3, and 5 are canceled and Claims 12-18 are withdrawn.

Claims 1, 4, 6-11 and 19-24 are rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 4, 6-11 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (US 6,105,008) in view of Johansen Jr., (US 6,785,938). Appellant appeals the rejections of Claims 1, 4, 6-11 and 19-24.

**IV. STATUS OF AMENDMENTS (37 C.F.R. §41.37 (c)(1)(iv))**

Appellants submitted an amendment to Claim 10 subsequent to the final rejection mailed 12/29/05. The proposed amendment would make Claim 10 depend from dependent Claim 6 instead of cancelled Claim 5. Both Claims 6 and 5 depend from independent Claim 1. The Examiner did not enter the amendment stating that the amendment to Claim 10 required "further search consideration." It is questioned how such an amendment could possibly involve a "further search consideration," assuming a complete search had been done on the first Office Action.

**V. SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. §41.37 (c)(1)(v))**

Independent Claim 1 relates to a method of conducting pet death, or pet related transactions over the Internet by providing at least one computer server for starting a client session, sending a command to start a client program, receiving commands from a remote computer, passing commands to a software session, and transmitting data to a remote computer. In addition, the computer server hosts one or more Internet web sites containing information and services related to the death of a pet and pet related information and services (p. 11, lines 14-23 bridging to p. 12; lines 1-3; and FIG. 1). Remote users are permitted to establish accounts and obtain information regarding or order pet death or pet related services from a plurality of associated sources and vendors (p. 7, lines 3-11; p. 11, lines 14-23, bridging to p. 12, lines 1-14; and p. 14, lines 17-24, bridging to p. 15, lines 1-8, and FIGS. 1, 1A and 11). Remote users are charged for obtaining information regarding or order pet death or pet related services from a plurality of associated sources and vendors via established accounts (p. 12, last paragraph bridging to p. 13, and FIGS. 3, 5).

Independent Claim 19 relates to a method of conducting pet-related transactions over the Internet by providing at least one computer server for starting a client session, sending a command to start a client program, receiving commands from a remote computer, passing commands to a software session, and transmitting data to a remote computer (p. 11, last paragraph bridging to p. 12; and FIG. 1). A pet calculator is provided that prompts specific input from a remote user, analyzes the input, and provides results and feedback to the remote user based on the input (e.g., p. 13, 1. 40, through p. 15, 1. 21.). There is also provided a pet selector that prompts specific input from a remote user, analyzes at least a portion of the input, and provides customized recommendations to the remote user (p. 16, 1. 11 through p. 17, 1. 6.). Remote users are permitted to establish accounts and obtain information regarding or order pet death or pet related services from a plurality of associated sources and vendors (p. 7, lines 3-12; p. 11, last paragraph through p. 12, 1. 14; p. 14, last paragraph bridging to p. 15; FIGS. 1, 1A and 11). Remote users are charged for obtaining information regarding or order pet death or pet related services from a plurality of associated sources and vendors via established accounts (p. 12, last paragraph through p. 13, 1. 4; and FIGS. 3, 5).

Independent Claim 21 provides a method of conducting transactions over the Internet related to commemorate the passing of a pet by providing at least one computer server for starting a client session, sending a command to start a client program, receiving commands from a remote computer, passing commands to a software session, and transmitting data to a remote computer (p. 11, last paragraph through p. 12, 1. 4; and FIG. 1). Remote users are permitted to establish accounts and obtain information or conduct transactions over the Internet related to commemorate the passing of a pet from a plurality of associated sources and vendors (p. 7, lines 3-12; p. 11 last paragraph through p. 12, 1. 14; p. 14, last paragraph through p. 15, 1. 8; FIGS. 1, 1A and 11; and Situational Examples 1 and 2, pages 17-33.).

**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. §41.37 (c)(1)(vi))**

1. Whether Claims 1, 4, 6-11 and 19-24 are properly rejected under 35 U.S.C. § 112, first paragraph.
2. Whether Claims 1, 4, 6-11 and 19-24 are properly rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al., US 6,105,008 ("Davis") in view of Johansen Jr., US 6,785,938 ("Johansen").

**VII. ARGUMENTS (37 C.F.R. §41.37 (c)(1)(vii))**

For the reasons set forth below, Appellant believes that Claims 1, 4, 6-11 and 19-24 are improperly rejected under 35 U.S.C. § 112, first paragraph and 35 U.S.C. 103(a).

**A. Claim Rejections Under 35 U.S.C. 112, Second Paragraph:**

The Examiner rejected Claims 1, 4, 6-11 and 19-24 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly Claim the subject matter which Applicant regards as the invention. In particular, the Examiner states that:

Claim 1, lines 1, 4, 9 "pet death" is not clear as to its meaning.

Claims 1, line 12 "regarding or order pet death" is not clear as to its meaning.

Claim 19, line 17 "regarding or ordering pet-related services" is not clear to its meaning.

Claim 21, line 2 "the passing" lacks antecedent basis and is not clear as to its meaning.

The Examiner bears the burden to present a prima facie case of indefiniteness for a rejection under 35 U.S.C. 112, second paragraph (see MPEP, 2173). The Examiner's focus during the examination of Claims is whether the Claim meets the threshold requirements of clarity and precision. (MPEP 2173.02). The Examiner has not presented a prima facie case for indefiniteness for each of the rejections under 35 U.S.C. 112, second paragraph. The Examiner provides no basis for the Appellant to know whether any analysis was done or the results of any analysis of the allegedly indefinite Claim language in view of (A) the content of the patent application disclosure; (B) the teachings of the prior art; and (C) the Claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made (MPEP 2173.02).

Appellant suggests that the Examiner is reading incorrectly parsing portions of the claims and leading to confusion.

The allegedly indefinite term "pet death" in Claim 1 line 1 is considered as modifying "transactions" and is set off in the alternative with "pet related" which also modifies transactions. The specification is replete with examples of at least the passing of pets, death of pets, mourning the death of a pet and mourning the death of VIP pets, and the

descriptions in paragraphs (p. 7, lines 3-22; p. 8, lines 9-18; p. 13, 1. 5 through p. 33, 1. 10). For at least these reasons, the term "pet death" has definite meaning in the context of the patent application disclosure.

The allegedly indefinite phrase "regarding or order pet death" in Claim 1, at line 12 is not being considered in the full context of the claim. In context, it is clear that the claimed remote users may do two things, namely, first, obtain information regarding or, second, order. What is the information regarding or what is ordered is provided in the next portion of the claim. Again, set out in the alternative, the remote users may obtain information regarding or order two things. The two things available to the remote users are both services – pet death services or pet related services. For the reasons stated in the paragraph above, the specification provides numerous examples of pet death and pet related services thereby making clear the meaning of these terms in the context of the specification. The same reasoning applies to the allegedly indefinite phrase "regarding or ordering pet-related services" in Claim 19, line 17.

The allegedly indefinite phrase "the passing" in Claim 21, line 2 is only so by incorrect parsing of the Claim element by the Examiner. Viewing the term in context reveals that the complete phrase is "to commemorate the passing of a pet." As set forth above, the various aspects of mourning and commemorating the death or passing of a pet are described at length in the specification.

For at least the reasons set forth above, the Examiner has not made out a prima facie case of indefiniteness. Even if such a case had been presented, the allegedly indefinite terms are in fact definite for at least the reasons set forth above. In view of the forgoing, it is requested that the rejections under 35 USC §112, first paragraph be withdrawn.

**B. Claim Rejections Under 35 U.S.C. 103:**

The Examiner rejected Claims 1, 4, 6-11 and 19-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Davis et al., US 6,105,008 ("Davis") in view of Johansen Jr., US 6,785,938 ("Johansen").

Davis relates to an online electronic bill paying architecture and system. Johansen describes a customizable pet urn manufacturing process.

The Examiner bears the burden of providing a prima facie case of obviousness of a Claim in view of the cited references. Included within the prima facie case is the identification of some reason, suggestion or motivation from the prior art as a whole for a person of ordinary skill in the art to have modified or combined the references. When the incentive to combine the teachings of the references is not readily apparent as is here, it is the duty of the Examiner to explain why the combination is proper. This has not been done.

The motivation to combine references in an obviousness rejection must come from the references themselves. No such motivation exists here. Instead, the Examiner is using the pending Claims to identify some reason to combine. It is plainly evident that Davis's online bill payment system has no relation to an automated urn design and manufacturing process. Similarly, Johansen's description an automated urn design and manufacturing process is not furthered or advantaged by Davis's online bill payment system.

Because the Examiner has not provided a prima facie showing of how independent Claims 1, 19 and 21 are obvious in view Davis and Johansen, Appellant requests that the rejection be withdrawn. Because independent Claims 1, 19 and 21 are not rendered obvious and are allowable, the dependent Claims 4, 6, 7, 8, 9 10, 11, 20, 22, 23, and 24 are also allowable.

For the reasons stated above, Claims 1, 4, 6-11 and 19-24 are patentable over the prior art of record, and the rejections those Claims under 35 U.S.C. §112, second paragraph and 35 U.S.C. §103(a) are improper and should be withdrawn. Appellants respectfully ask the Board to overturn the Examiner's rejection with instructions to allow the claims.

The Commissioner is authorized to charge any fees that may be required in connection with this submission, including petition fees and extension of time fees, and to credit any overpayments to Deposit Account No. 23-2415 (Attorney Docket No. 30841-703.201).

Respectfully submitted,

Date: August 17, 2006

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